

Serial No: 10/720,422
Filed: November 24, 2003
Docket: 2154 US

REMARKS

Claims 30-48 are pending in the present application. By the Office Action dated September 25, 2006, the Examiner has rejected claims 30-48. The foregoing amendments and the following remarks are responsive to the rejections and objection presented in the Examiner's Office Action.

Rejections under 35 U.S.C. § 112

The Examiner rejected claim 44 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention. The Examiner states in this regard that there is insufficient antecedent basis for the limitation "the optical element" in line 6 of claim 44. Applicant has amended claim 44 and replaced "optical element" with "hologram" which has proper antecedent basis and is in line with the independent claim from which it depends. Applicant respectfully requests the Examiner remove this rejection and allow claim 44.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 30-48 under 35 U.S.C. 103 (a) as being unpatentable over U.S. Patent No. 6,637,884 to Martino (Martino). With regard to independent claims 30, 37 and 43, the Examiner states that "Martino discloses an aberrometer calibration comprises an optical element (32) insertable into an optical path (40) of a wavefront analyzer (10), the optical element (32) adapted to induce a predetermined aberration in a wavefront for presentation to the wavefront analyzer (figure 2, column 3, line 63 through column 4, line 25). Martino teaches that the calibration component comprises a well characterized test optic or model eye having a known wavefront aberration, or having known plus or minus dioptric power and the desired measurement parameter is a refractive calibration (column 2, lines 5-31). Martino does not explicitly teach the use of a hologram; however, it would have been

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obvious to one having ordinary skill in the art at the time the invention was made to use any types of calibration component, for example, a hologram as now claimed by the present invention . . . “

In order to establish a *prima facie* case of obviousness, Section 2143 of the MPEP requires that:

...three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Addressing the first criteria, the MPEP prescribes in Section 706.02(j) that:

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

In the most recent Action, the Examiner has not pointed out any teaching in the cited references that “expressly or impliedly suggest[s] the claimed invention” (i.e., use of a hologram as a calibration component). Nor has the Examiner “present[ed] a convincing line of reasoning as to why the artisan would have found

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the claimed invention to have been obvious in light of the teachings of the references.” The only teaching of the use of a hologram as a calibration component, in this case, is in the Applicant’s own application. Thus, the Examiner’s rejection fails to meet the first criteria for a *prima facie* case of obviousness.

Applicant therefore respectfully requests the Examiner withdraw the rejection and allow claims 30, 37 and 43. Claims 31-36 depend from independent claim 30 and as such each is patentably distinct and allowable as a further limitation upon claim 30. Claims 38-42 depend from independent claim 37 and as such it is patentably distinct and allowable as a further limitation upon claim 37. Claims 44-48 depend from independent claim 43 and as such each is patentably distinct and allowable as a further limitation upon claim 43. Therefore, Applicant also respectfully requests that the Examiner allow claims 31-36, 38-42, and 44-48.

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CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for allowance. For all of the foregoing reasons, Applicant respectfully submits that claims 30-48 are in condition for allowance, and respectfully requests allowance of claims 30-48.

An extension of three (3) months is requested and a Notification of Extension of Time Under 37 C.F.R. § 1.136 with the appropriate fee is attached hereto.

The Examiner is invited to contact the undersigned by telephone or facsimile if the Examiner believes that such a communication would advance the prosecution of the present invention.

Respectfully submitted,

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